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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,481	04/12/2001	Chang Wan Ryoo	P66550US0	5900

136 7590 11/18/2002

JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, DC 20004

EXAMINER

KIM, AHSHIK

ART UNIT PAPER NUMBER

2876

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,481

Applicant(s)

RYOO, CHANG WAN

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: .

DETAILED ACTION

Continuation Data

1. Acknowledged this application is a national stage entry of PCT/KR00/00639, filed June
5 16, 2000.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers
10 have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

- 15 A person shall be entitled to a patent unless –
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for
20 patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment
25 by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Risafi et al. (US 6,473,500).

Re claim 1, Risafi teaches an electronic payment system (col. 1, lines 10+; col. 10, lines 1+) comprising a prepaid card in the form of smart card or a magnetic stripe card (col. 1, lines 54+). As indicated in the abstract, the card is used to purchase a wide range of goods and services and to perform other functions (see abstract; col. 17, line 66 – col. 18, line 3).). Figure 5a discloses an initial account setup up with PIN assignment and balance (col. 12, lines 26-51). Figure 9a – 9d disclose purchase, use and reloading of the prepaid smart card.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risafi et al. (US 6,473,500) in view of Gottfreid (US 6,076,076). The teachings of Risafi have been discussed above.

Re claims 2 and 5, although Risafi discloses the methods for distributing such cards (col. 10, lines 9+), Risafi fails to specifically teach or fairly suggest of selling the pre-paid card over the Internet.

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Gottfreid discloses prepaid print card system (see abstract) wherein the card can be purchased on-line (over the Internet) (col. 1, lines 33+).

In view of Gottfreid's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known on-line sales mechanism to the teachings of Risafi in order to provide easier access to purchase such pre-paid cards, and thus increase overall sales. Selling services/products over the Internet is well known in the art, and widely used. By allowing the users to purchase the card over the Internet (as opposed to designated sites or via the agents), the users can readily obtain the card. Moreover, such self-purchase over the Internet will lessen the burden of the agents, so that the agents, in turn, can focus their efforts on other important tasks such account maintenance, customer service and sales, and therefore an obvious expedient.

Re claim 3, the embodiment disclosed in Risafi also includes a case wherein the card can be purchase and given as a gift to another person as shown in figure 10a (col. 18, lines 43+).

Re claim 4, as shown in step 270 in figure 2, the pre-paid card can be replenished (col. 10, lines 58+). Or a sender can add value to recipient's card (col. 19, lines 28+; See figure 10c, step 1082).

5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risafi et al. (US 6,473,500) in view of Kawan (US 6,442,532). The teachings of Risafi have been discussed above.

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Risafi further discloses a device equipped with interactive voice response unit (IVRU), which guides users with their transaction (col. 3, line 65 – col. 4, line 16). Risafi, however, fails to specifically teach or fairly suggest that such device is a mobile phone.

Kawan teaches a wireless transaction and information system (figure 4) comprising a
5 cellular telephone terminal as shown in figure 2c and a prepaid smart card, which can be used in various transaction terminals (col. 6, lines 39+).

In view of Kawan's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate a well-known transaction terminal such as a mobile telephone to the teachings of Risafi in order to provide mobility to the users in
10 performing such transactions. Risafi's embodiment discloses TELCOs and their networks in many occasions, without specifically referring to mobile telephones. It is Examiner's view that the TELCOs provide mobile network and cellular service as one of the products. However, in view of Kawan, the users can access the network and desired service by use of cellular/mobile phone, regardless of agent's location or schedule. Moreover, the transaction can be initiated in
15 more private environment, avoiding potential danger of theft, identity theft, robbery, etc, and thus an obvious expedient.

Conclusion

20 I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Dorf (US 6,189,787); Albrecht (US 6,182,895); Walker et al. (US 6,138,106); Walker et al. (US 5,945,653); Spector (US 5,870,718); Gottlich et al. (US 6,024,288) disclose prepaid cards, and the systems utilizing prepaid cards.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The

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examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Ahshik Kim
Patent Examiner
Art Unit 2876
November 12, 2002


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800